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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,488	09/04/2003	Wayne H. Rothschild	WMS021	5869
70243	7590	10/18/2007		
NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213			EXAMINER YOO, JASSON H	
			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			10/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/655,488

Applicant(s)

ROTHSCHILD ET AL.

Examiner

Jasson H. Yoo

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 15, 29, 28 and the dependent claims of thereof are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite "a primary purpose is not directed to identifying the patron at a game venue". The negative limitation is not supported by the specification.

Claims 7, 20, 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 7, 20, 43, recite the limitation of "the identifying information unique to the patron and easily remembered by the patron". The ability to remember information varies from person to person. Applicant's specification does not teach how a patron easily remembers the identifying information. The claim may be directed to the information. However, the claim requires the patron easily remember this information.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "receiving a universal personal identifier in a form of a tangible object". The claim also recites a universal personal identifier device for receiving the universal personal identifier. There is insufficient antecedent basis for this limitation in the claim. It is not clear if the universal personal identifier device refers to the same device as the universal personal identifier in form of a tangible object whose primary purpose is not directed to identifying the patron at a game venue, or if the universal personal identifier device refers to a different device from the universal personal identifier in form of a tangible object whose primary purpose is not directed to identifying the patron at a game venue. If the universal personal identifier in a tangible object is separate device from the universal personal identifier device, it is not clear how the universal personal identifier device is capable of transmitting the patron identification, when the patron identification ins within the universal personal identifier object.

Claims 2-14 are rejected as discussed above for incorporating the limitations of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-23, 25-46, 48 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick et al (US 6,908,387) in view of Giobbi (US 2003/0045354)

1, 15. Hedrick discloses a method for associating a patron with wagering game play at a gaming machine in a server-based gaming network, the method comprising:

- associating a unique patron identification with the patron (associate a player with a player tracking account, col. 2:20-23);
- establishing a patron account for the patron, the patron account being identified by the unique patron identification (establish a patron account with player tracking information, cols. 1-46-2:25, 3:5-33);
- providing a the gaming machine in a server-based gaming network (Fig. 5) with a universal personal identifier device for receiving a universal personal identifier having a patron identification, the universal personal identifier device being capable of detecting and transmitting the patron identification (player tracking device receives and transmit player information, cols. 2:47-64, 3:64-47);
- receiving the patron identification (player receives the patron identification from the casino in a form of a player tracking card, col. 1:47-27; player tracking unit receives

patron information from the player tracking card/ or from the player, col. 2:35-47, 3:5-21; gaming machine receives patron identification from the player tracking device, col. 3:50-65; server receives patron identification from the gaming machine or player tracking device, cols. 2:48-59, 3:23-33; gaming machine receives the patron identification the sever, col. 3:34-47).

comparing the patron identification to the unique patron identification (col. 3:23-33); and

enabling collection of patron accounting data resulting from wagering game play if the patron identification matches the unique patron identification (col. 3:22-47).

Hedrick discloses the claimed invention as discussed above, but fails to specifically teach the universal personal identifier in a form of a tangible object whose primary purpose is not directed to identifying the patron at a game venue, the universal personal identifier having a patron identification. However, in an analogous art to player tracking devices for game machines, Giobbi discloses a universal personal identifier in a form of a tangible object whose primary purpose is not directed to identifying the patron at a game venue, the universal personal identifier having a patron identification (paragraph 11). More specifically, the universal personal identifier may be a mobile telephone, watch, necklace, key, ring, belt buckle, or any other typical device carried by casino patrons (paragraph 11). Giobbi discloses that the player tracking identifier can be in any design, which may be easily carried by the player. When the player tracking identifier is in the form of a player's typical belonging, the player can easily access the

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player's information when playing the gaming machine without carrying an extra player tracking card. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hedricks' invention and incorporate Giobbi's universal personal identifier, in order to allow players to easily access the players' information without carrying an extra player tracking card.

Hedrick in view of Giobbi further teaches the following:

2, 16, 39. The method of claim 1, wherein the universal personal identifier device comprises a card reader (Hedrick, col. 2:36).

3, 17, 40. The method of claim 2, wherein the universal personal identifier comprises a credit card (Hedrick, col. 17:26-35).

4, 18, 41. The method of claim 2, wherein the universal personal identifier is selected from the group consisting of a magnetic card, an optical card, a bar coded card, and a memory card (Hedrick, col. 3:9).

5, 19, 42. The method of claim 4, wherein the memory card is selected from the group consisting of a compact flash card, a memory stick, a smart card, a radio frequency card, a combination smart card, and a hybrid card (Hedrick, col. 3:9).

6, 21, 44. The method of claim 1, wherein the universal personal identifier device comprises a biometric device, and wherein the universal personal identifier comprises a biometric input by the patron (Hedrick, 10:24).

7, 20, 43. The method of claim 1, wherein the universal personal identifier device comprises a touch screen, and wherein the universal personal identifier comprises identifying information entered by the patron, the identifying information unique to the patron and easily remembered by the patron (finger-print reader is a touch screen that identifies the patron, Hedrick, 10:24).

8, 22, 30, 45. Hedrick significantly discloses the claimed invention as discussed above. Hedrick further discloses the a universal person identifier is a portable wireless device with Bluetooth capability such as a personal digital assistant or some other device worn or carried by the player (Hedrick, col. 5:60-6-6), but fails to specifically teach a Bluetooth mobile phone. Giobbi discloses cell phones (paragraph 11). Bluetooth mobile phones are portable devices that have Bluetooth capability. Bluetooth mobile phones are used as a portable communication device to communicate with computers and gaming devices. Having mobile phones to connect to the Hedrick's gaming device will allow players with mobile phones to connect with player tracking without carrying additional player tracking portable device. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedrick's gaming device, and incorporate Bluetooth mobile phone in order to



allow players with mobile phones to connect with player tracking without carrying additional player tracking portable device.

9, 23, 31, 46. The method of claim 1, wherein the universal personal identifier device comprises a Bluetooth.TM. module device, and wherein the universal personal identifier comprises a Bluetooth.TM. handheld device (Hedrick, cols. 5:63-6:6, 6:43-46, 10:46-11:25).

11, 25, 33, 48. The method of claim 1, further comprising: detecting a wager for wagering game play at the gaming machine; collecting the patron accounting data resulting from wagering game play; and providing the patron accounting data to the patron account (Hedrick, col. 2:48-64).

12, 26, 34, 49. The method of claim 11, further comprising enabling the patron to access the patron account if the patron identification matches the unique patron identification (Hedrick, col. 17:38-44).

13, 27, 35, 50. Hedrick significantly discloses the claimed invention as discussed above. Hedrick further discloses applying a promotional credit to the patron account based on the patron accounting data; enabling the patron to access the patron account if the patron identification matches the unique patron identification; and enabling the patron to transfer the promotional credit to the gaming machine (as noted in the claims

above). However Hedrick fails to teach permitting the patron to wager the promotional credit for wagering game play on the gaming machine. However, it is well known in the art to provide various promotional credits to a patron. Many promotional awards are provided by the casino, which can be purchased by the promotional credits. One common promotional award is wagering credits used for the casino. Wagering credits encourages the patron to revisit the casino and stay in the casino longer. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedrick's gaming device and permit the patron to wager the promotional credit for wagering game play on a gaming machine, in order to encourage the patron to revisit the casino and stay in the casino longer.

14, 37. The method of claim 1, wherein the wagering game is selected from the group consisting of mechanical slots, video slots, video poker, video blackjack, video keno and video bingo (Hedrick, col. 2:26-61).

28. The method of claim 15, wherein the spending activity is selected from the group consisting of lodging spending, restaurant spending, entertainment spending, and merchandise spending (spending on entertainment such as a wagering game, meals and rooms, Hedrick, col. 17:52-59).

29. See rejection for claim 1. Furthermore, Hedrick discloses Bluetooth for wireless communication (col. 6:3).

32. The method of claim 29, wherein detecting establishment of a Bluetooth T wireless connection comprises: detecting establishment of a Bluetooth.TM. link between the Bluetooth.TM. module and the Bluetooth.TM. portable device; detecting establishment of a Bluetooth.TM. channel between the Bluetooth.TM. module and the Bluetooth.TM. portable device; and detecting establishment of a Bluetooth.TM. high layer connection between the Bluetooth.TM. module and the Bluetooth.TM. portable device (standard Bluetooth wireless communication protocol, Hedrick, cols. 5:66-6:6, 10:57-25).

36. The method of claim 29, further comprising disabling collection of the patron accounting data resulting from wagering game play when the Bluetooth.TM. wireless connection between the Bluetooth.TM. module and the Bluetooth.TM. portable device is not established (A connection between the portable device and the player tracking unit is required for the patron to access the accounting data from the server. Therefore access to the accounting data from the server is disabled when a connection is not established, Hedrick, cols. 2:48-54, 3:5-47, 10:46-11:25).

38. See rejection for claim 1.

Hedrick further disclose a server-based gaming network that allows a patron with a universal personal identifier to be associated with wagering game play at a gaming machine, the server-based gaming network comprising:

- a plurality of gaming machines (Hedrick, 100, 101, 102, 103, in Fig. 1), at least one of the gaming machines comprising:

- a value input device (Hedrick, 220 in Fig. 3 and 32 in Fig. 4);

- a video display capable of displaying video images associated with the wagering game play (34 in Fig. 4);

- a universal personal identifier device configured to receive a universal personal identifier having a patron identification (Hedrick, col. 2:35-47), and configured to detect the patron identification (Hedrick, col. 3:5-22) from the universal personal identifier; and

- a gaming machine controller operatively coupled to the value input device, the video display and the universal personal identifier device, the gaming machine controller comprising a processor and a memory coupled to the processor of the gaming machine controller, the gaming machine controller being programmed to (Hedrick, 104 in Fig. 1)

- receive the patron identification from the universal personal identifier device, allow the patron to make a wager for the wagering game play, cause a video image representing an outcome of the wagering game play to be displayed on the video display, and determine a value payout associated with the outcome (Hedrick, col. 2:48-55); and

- a server operatively coupled to the at least one of the gaming machines, the server comprising: a server controller, the server controller comprising a processor and

a memory coupled to the processor of the server controller, the server controller being programmed to: associate a unique patron identification with the patron, establish a patron account for the patron, the patron account being identified by the unique patron identification, receive the patron identification from the gaming machine controller, compare the patron identification to the unique patron identification, and enable collection of patron accounting data resulting from the wagering game play if the patron identification matches the unique patron identification (Hedrick, cols. 2:48-66, 3:34-47, 14:21-42, 17:51-18:5).

Claims 10, 24, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick et al (US 6,908,387) in view of Giobbi (US 2003/0045354) as applied to claims 1, 15, 38 above, and further in view of Kermode (GB 2363950)

Hedrick in view of Giobbi discloses the claimed invention as discussed above. However, Hedrick in view of Giobbi fails to teach the universal personal identifier comprises a microchip embedded in the patron. However, in an analogous art to data storage. An embedded microchip in a person allows the person to easily access the information contained in the embedded microchip, without having the person to carry an external storage device. Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Hedrick in view of Giobbi's gaming system, and incorporate Kermode embedded microchip, in order to allow player access player tracking information without carrying an external tracking device.

***Response to Arguments***

Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHY

  
XUAN M. THAI  
SUPERVISORY PATENT EXAMINER  
TC3701